REMARKS

Applicant has studied the Office Action dated January 31, 2005, and has made amendments to the claims. Claims 1-18 are pending. Claims 1, 8, 11 and 17 are independent claims. Claims 1, 3-5 and 8-18 have been amended. No new matter has been entered. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to the Specification

Amendments have been made to the specification at pages 4 and 12-14 to correct typographical errors and more clearly disclose the invention. No new matter has been added as the amendments have support in the specification and drawings as originally submitted.

§ 102 Rejections

Claims 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Roeck et al. ("Roeck" U.S. Patent No. 6,574,796). This rejection is respectfully traversed.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 has(Fed. Cir. 1991).

Claim 1 has been amended to more clearly disclose the invention. In paragraph 4 of the Office action, the Examiner asserts several portions of Roeck as disclosing the recited claim limitations. Applicant respectfully disagrees with the Examiner's interpretation of Roeck and each claim limitation is discussed individually.

With regard to the preamble, the Examiner asserts that Roeck discloses "an initialization file download apparatus." It is respectfully noted that Roeck is directed to "locating or detecting an appropriate data carrier in a downstream channel upon powering up a cable modem" rather than an apparatus to download "an initialization file." See Roeck et al. col. 7, ll. 27-30.

The Examiner asserts that a "a tuner unit for tuning a plurality of downstream signals and upstream signals" is disclosed at col. 11, ll. 58-61. It is respectfully noted that the cited portion of Roeck discloses only that a "downstream channel is routed to tuner 504." It is respectfully submitted that nowhere in Roeck is tuning of "upstream signals" disclosed.

The Examiner asserts that "a downstream unit for demodulating the downstream signal inputted from the tuner unit and separating a general data and an MAC management message" is disclosed at col. 12, ll. 3-5 as "a receiver chip that demodulates the data." It is respectfully noted that the disclosure is that "[r]eceiver chip 508 is essentially a demodulator that attempts to decode the intermediate frequency data signal having a particular frequency." It is respectfully submitted that "a demodulator that attempts to decode" the data signal is not sufficient to disclose "separating a general data and an MAC management message" as recited in the claim.

The Examiner asserts that "a message processor for detecting configuration file name information and MAP information according to the MAC management message inputted from the downstream unit" is disclosed at col. 12, ll. 15-21 as "a receiver chip in conjunction with the central processing unit can process data from downstream." It is respectfully noted that the disclosure is that a "comparison is performed by receiver chip 508" and that the "comparison" is, per col. 12, ll. 10-12, of the "data signal to one of several constellation diagrams." It is respectfully submitted that comparing the "data signal to one of several constellation diagrams" is not sufficient to disclose "detecting configuration file name information and MAP information" as recited in the claim.

The Examiner asserts that "a non-volatile memory for storing the configuration file name information detected from the message processor" is disclosed at col. 12, ll. 16-17 as "a CPU with its own memory for storing data." It is respectfully noted that no particular function is disclosed with respect to "memory 512." It is respectfully submitted that the function that is inherent in the disclosure for "memory 512" is related to the comparison of the "data signal to one of several constellation diagrams" and that this is not sufficient to disclose "storing the configuration file name information detected from the message processor" as recited in the claim.

The Examiner asserts that "an upstream unit for generating/modulating the upstream signal according to the MAP information detected from the message processor" is disclosed at col. 12, ll. 30-34 and 38-40 as "a transmitter chip which modulates and prepares the signal for transmission upstream." It is respectfully noted that the disclosure is that "transmitter chip 516 ... modulates ... the signal in QAM or QPSK." It is respectfully submitted that modulating the signal "in QAM or QPSK" is not sufficient to disclose "generating/modulating the upstream signal according to the MAP information detected from the message processor" as recited in the claim.

It is respectfully asserted that Roeck fails to disclose each element of claim 1 and, therefore, the claim is allowable over the cited reference.

Claims 8, 10, 11 and 13-16 were rejected under 35 U.S.C. § 102(e) as being anticipated by DiNatale et al. ("DiNatale" WIPO Pub. No. WO 02/48897 A1). This rejection is respectfully traversed.

Independent claims 8 and 11 as well as dependent claims 10 and 13-16 have been amended to more clearly disclose the invention. In paragraph 5 of the Office action, the Examiner asserts several portions of DiNatale as disclosing the recited claim limitations. Applicant respectfully disagrees with the Examiner's interpretation of DiNatale and each claim is discussed individually.

With regard to independent claim 8, the Examiner asserts that "a delimiter part differentiating the configuration file name part and the configuration file version part" is disclosed in Figure 4 as "a file format which has specified lengths for the data to be differentiated." It is respectfully noted that neither FIG. 4 nor the portion of DiNatale related to FIG. 4 discloses any "delimiter part." It is further respectfully noted that the specification of the present invention, in FIG. 6B, discloses a "delimiter part 62" that has a finite size. It is respectfully submitted that a file format that has "specified lengths" for the data without any disclosure of any "delimiter part" is not sufficient to disclose "a delimiter part differentiating the configuration file name part and the configuration file version part" as recited in the claim.

With regard to independent claim 11, the Examiner asserts that "registering configuration file name information in a DHCP server" is disclosed at pg. 10, ll. 7-10 as "the DHCP server can determine the file name information from the cable modem." It is respectfully noted that the disclosure is that "the DHCP server can interrogate the cable modem 20 to determine the cable brand and model number ... [and] identifies the applicable cable modem operating software file name as shown in [a] table." It is further respectfully noted that the specification of the present invention, at page 11, ll. 11-14 discloses that a "manager ... constructs the configuration file name ... and registers it in the DHCP server." Therefore, it is respectfully submitted that it is not the "DHCP server" itself that registers the "configuration file name" in the DHCP server, but rather a separate entity and the "DHCP server" interrogating the modem is not sufficient disclose "registering configuration file name information in a DHCP server" as recited in the claim.

Further with regard to independent claim 11, the Examiner asserts that "comparing the received first configuration file name information with a previously stored second configuration file name information" is disclosed at pg. 7, ll. 29-31 as "the file name is read and compared to the file name downloaded in the previous power-up process." It is respectfully noted that the

disclosure is that "[a]t a step 86, the operating software table file name ... is compared with the software table file name downloaded during a previous power-up."

It is respectfully submitted that DiNatale does not disclose the "configuration file name" information is compared with previously stored "configuration file name" information as recited in the claim, but rather discloses the comparison of "operating software table file name" information with previously stored "operating software table file name" information. It is further respectfully submitted that the "operating software file name" disclosed in DiNatale is not the same as the "configuration file name" information recited in the claim.

Further with regard to independent claim 11, the Examiner asserts that "downloading the received first configuration file name information, if the received first configuration file name/version is more updated file than the second configuration file name/version upon comparison" is disclosed at pg. 7, line 31 to pg. 8, line 1 and pg. 10, ll. 9-13 as "if the version numbers do not match then the latest version of the file is downloaded." It is respectfully noted that that the disclosure is "[i]f the version numbers do not match, then the processing moves to a step 88 where the latest version of the operating software table file is downloaded." It is respectfully submitted that the "operating software table file" disclosed in DiNatale is not the same as the "configuration file name information" recited in the claim.

Further with regard to independent claim 11, the Examiner asserts that "updating the memory with the downloaded first configuration file name information" is disclosed at pg. 9, ll. 16-25 as "the cable modem stores the file name so at the next power-up the stored value can be compared, it also downloads the latest version." It is respectfully noted that the disclosure is "[a]t a step 94, the cable modem 20 stores the operating software table file name." As was previously submitted, the "operating software table file name" is not the same as the "configuration file name information" recited in the claim.

With regard to claim 13, the Examiner asserts that "comparing a file name of the received first configuration file name information and that of the stored second configuration file name information" is disclosed at pg. 7, ll. 29-31 as "the names are compared." It is respectfully noted that the portion of DiNatale to which the Examiner refers is the description of "step 86" in FIG. 3. It is further respectfully noted that DiNatale discloses, at pg. 7, ll. 31-32, that "[i]f the version numbers do not match, then the processing moves to a step 88." Moreover, it is respectfully noted that "step 86" in FIG. 3 indicates "SAME VERSION?"

Therefore, it is respectfully submitted that DiNatale does not disclose that the "configuration file" name is compared with a previously stored "configuration file" name as recited in the claim, but rather discloses the comparison of the "version numbers" of "operating

software table" files. As was previously submitted with respect to claim 11, an "operating software table file" is not the same as the "configuration file name information" recited in the claim.

Further with regard to claim 13, the Examiner asserts that "downloading the first configuration file name information if the first configuration file name and the second configuration file name are different to each other, and comparing the first configuration file version information and the second configuration file version information if the first configuration file name is identical to the second configuration file name" is disclosed at pg. 8, line 26 to pg. 9, line 13 as "the file contains major revision numbers, minor revision numbers, and patch revision numbers which are used to compare the stored file with the file name downloaded." It is respectfully noted that the disclosure is that "at a step 92 the cable modem 20 compares the operating software file name from the table with the operating software file name stored in the cable modem memory" and "[a] match between these two file names indicates that the cable modem 20 is already using the latest operating software ... [and] it can be concluded that the new revision table file name must have been due ... not [to] a change in the operating software file name for this modem." It is further respectfully noted that "step 92" in FIG. 3 is performed regardless of the result of the previous comparison of "version numbers" in "step 86."

As was previously submitted with regard to claim 11, DiNatale does not disclose "downloading the first configuration file name information if the first configuration file name and the second configuration file name are different to each other" as recited in the claim, but rather discloses downloading the different "operating software table" file name and the downloading is based on a comparison of "version numbers" as opposed to a comparison of "file names." It is further respectfully submitted that DiNatale does not disclose performing the comparison "if the first configuration file name is identical to the second configuration file name" as recited in the claim, but rather discloses comparing the "operating software" file name to a previous "operating software" file name and the comparison is performed regardless of the result of any pervious comparison. Moreover, it is respectfully submitted that DiNatale does not disclose any comparison of the "file version" if the "first configuration file name is identical to the second configuration file name" as recited in the claim, but rather discloses that it is assumed that "the cable modem 20 is already using the latest operating software" if the names are identical (a fact that the Examiner appears to admit with regard to his assertion with respect to claim 14).

In summary, claim 13 recites performing a comparison of "configuration file" names, downloading the received "configuration file name information" if the "configuration file" names are different, comparing the "versions" of the "configuration file information" if the "configuration

file" names are identical, and downloading the received "configuration file name information" if the "versions" are different. On the other hand, DiNatale discloses performing a comparison of "operating software table file" name "versions" in step 86, downloading the latest version of the "operating software table" file in step 88 if the "operating software table file" name "versions" are different, comparing the "names" of the "operating software files" in step 92 regardless of whether the "versions" of the "operating software table file" names are identical, and downloading the received "operating software file" in step 96 if the "names" are different. It is respectfully submitted that the succession of steps related in claim 13 is patentably different from the succession of steps disclosed in DiNatale.

With regard to claim 14, the Examiner asserts that "performing a registration process of a cable modem by using the stored second configuration file name information, if the first configuration file version information is lower than or the same as the second configuration file version information" is disclosed at pg. [9], ll. 12-13 as "if there is a match between the two files then the cable modem is already using the latest version of the software." As was previously submitted with regard to claim 13, the cited portion of DiNatale does not disclose comparing any "file version" as recited in the claim.

With regard to claim 15, the Examiner asserts that "a delimiter differentiating the file name part and the file version information part" is disclosed in Figure 4 as "a file format which has specified lengths for the data to differentiated." As was previously submitted with regard to claim 8, DiNatale does not disclose any "delimiter" as recited in the claim.

With regard to claim 16, the Examiner asserts that "the second configuration file name information is downloaded in the previous process of initializing the cable modem" is disclosed at pg. 9, ll. 16-20 as "the cable modem stores the file name so at the next power-up this stored value can be used in the comparison process." As was previously submitted with regard to claim 11, the cited portion of DiNatale does not disclose downloading "configuration" file information as recited in the claim but rather downloading the different "operating software table" file information.

It is respectfully asserted that DiNatale fails to disclose each element of independent claims 8 and 11 and dependent claims 13-16 and, therefore, the claims are allowable over the cited reference. It is further respectfully asserted that claim 10, which depends from claim 8, also is allowable over the cited reference as are claims 13-16 based on their dependence from claim 11.

§ 103 Rejections

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck et al. in view of Welles, II et al. ("Welles" U.S. Pat. No. 6,532,495). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

Applicant respectfully submits that the combination of the Roeck and Welles references is improper. It is respectfully requested that the reject be withdrawn.

It is well settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicants' specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

The Examiner indicates, at paragraph 15 of the Office action, that Roeck "fails to teach of the data in the downstream unit being transmitted to a display unit and to a message processor" and asserts that Welles teaches "of a data receiver connected to an input connection and also to a television set." The Examiner further asserts, at paragraph 16 of the Office action, that Roeck and Welles are analogous art because "they both are related to data transmission through a cable modem" and further asserts, at paragraph 17 of the Office action, that "it would have been obvious to a person of ordinary skill in the art to use the connection in Welles ... and adapt it to the device in Roeck." Moreover, the Examiner cites a portion of Welles, at col. 7, ll. 38-40, to support the proposed combination of references on the basis that "the data connection line carries two types and data can be conducted to both a display and to the message processor."

It is respectfully noted that the Roeck invention is directed to "enabling a cable modem to efficiently detect a data carrier in the downstream band" while the Welles invention is directed to "a system for enhancing the process of downloading files from the internet." See Roeck at col. 7, ll. 27-30 and Welles at col. 3, ll. 60-61. It is further respectfully noted that the present invention is directed to "a file download apparatus and method ... that is capable of shortening the time required for initializing a cable modem." See specification at pg. 1, ll. 7-9. Although the

Roeck and Welles references may both be related to the same general art, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to look to an invention (Welles) directed to "enhancing the process of downloading files from the internet" for ways to modify an invention (Roeck) directed to "efficiently detect[ing] a data carrier" in order to meet the need (of the present invention) of "shortening the time required for initializing a cable modem."

It is further respectfully submitted that the Examiner has not asserted the proper motivation for modifying the Roeck invention with the teachings of the Welles reference and is engaging in hindsight reconstruction of the claimed invention. For example, the Examiner has not pointed to any portion of the Roeck reference or Welles reference that would motivate one of ordinary skill in the art to make the proposed modification of the Roeck invention.

The Examiner cites a portion of the Welles invention that supports only the proposition that the **Welles** invention may be modified such that "the general data of the downstream unit is transmitted to a display unit that can be viewed by a user through an MPEG 2 transport stream interface, and the MAC management message is transmitted to the message processor" as recited in claim 2 or, in other words "the mere fact that a reference may be modified in the direction of the claimed invention." However it is the **Roeck** invention, not the Welles invention, that the Examiner is proposing to modify and the only motivation the Examiner asserts outside the Welles reference are the teachings of the **present** invention.

The Federal circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed Cir. 1987). Rather than pointing to what the prior art discloses and teaches as to making the suggested configuration, the Examiner relies on assumptions and statements without any support in the record. The Examiner relies on impermissible hindsight to avoid express limitations in the claim by making assertions regarding how the Welles invention may be adapted to recreate the claimed invention. Therefore, the Examiner has failed to establish a prima facie case of obviousness.

It is respectfully noted that "In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is further respectfully submitted that claim 2 is allowable even in view of the Examiner's asserted combination of references. Since Welles fails to cure all the deficiencies of Roeck with respect to independent claim 1 that were submitted previously with regard to the 102(e) rejection. Therefore, it is respectfully asserted that claim 1 is allowable over the cited references, as is claim 2 based on its dependence from claim 1.

Claims 3, 4 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of DiNatale. This rejection is respectfully traversed.

Applicant respectfully submits that the combination of the Roeck and DiNatale references is improper. It is respectfully requested that the reject be withdrawn.

Claims 3 and 4 have been amended to more clearly define the invention. With respect to claim 3, the Examiner indicates, at paragraph 19 of the Office action, that Roeck "fails to teach of a process which stores information in memory only when the detected information is newer than the one already stored" and asserts that DiNatale teaches "of a process where the information is saved in memory if it is more recent than the previous information." With respect to claim 4, the Examiner indicates, at paragraph 22 of the Office action, that Roeck "fails to teach of a process where the CPU compares the information detected by the message processor and the information stored in memory and then selects the one with the higher version" and asserts that DiNatale teaches "a process where information is read and compared to information downloaded during a previous power up and now stored in the modem" and "if the information does [is] not the same then the latest version is saved in the modem." With respect to claim 7, the Examiner indicates, at paragraph 25 of the Office action, that Roeck "fails to teach of storing the information inside the memory" and asserts that DiNatale teaches "storing the information in the cable modem memory in order to compare it with future versions."

The Examiner further asserts, at paragraphs 20, 23 and 26 of the Office action, that Roeck and DiNatale are analogous art because "they both are related to data transmission through a cable modem" and further asserts, at paragraphs 21, 24 and 27 of the Office action, that "it would have been obvious to a person of ordinary skill in the art to use the process of comparing the information in DiNatale et al. with the device taught by Roeck et al." Moreover, the Examiner cites a portion of DiNatale, at pg. 10, ll. 24-27, to support the proposed combination of references on the basis that it "will ensure that all the capabilities included within the cable modem are utilized during operation."

As was previously noted with respect to the rejection of claim 2, the Roeck invention is directed to "enabling a cable modem to efficiently detect a data carrier in the downstream band" and the present invention is directed to "a file download apparatus and method ... that is

capable of shortening the time required for initializing a cable modem." Although the Roeck and DiNatale references may both be related to the same general art, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to modify an invention (Roeck) directed to "efficiently detect[ing] a data carrier" in order to meet the need (of the present invention) of "shortening the time required for initializing a cable modem."

It is further respectfully submitted that the Examiner has not asserted the proper motivation for modifying the Roeck invention with the teachings of the DiNatale reference and is engaging in hindsight reconstruction of the claimed invention. For example, the Examiner has not pointed to any portion of the Roeck reference or DiNatale reference that would motivate one of ordinary skill in the art to make the proposed modification of the Roeck invention.

The Examiner cites a portion of the DiNatale invention that supports only the proposition that the **DiNatale** invention may be modified such that "the message processor stores the detected configuration file name information in the non-volatile memory only when the detected configuration file name information is more lately updated one than the configuration file name information previously stored in the non-volatile memory" as recited in claim 3, such that "the CPU compares the configuration file name information detected by the message processor and the configuration file name information stored in the non-volatile memory, and selects the configuration file name information of a higher version" as recited in claim 4, or such that "the non-volatile memory stores the configuration file name information for initializing the cable modem" as recited in claim 7. It is respectfully submitted that the Examiner has only shown "the mere fact that a reference may be modified in the direction of the claimed invention." However it is the **Roeck** invention, not the DiNatale invention, that the Examiner is proposing to modify and the only motivation the Examiner asserts outside the DiNatale reference are the teachings of the **present** invention.

Rather than pointing to what the prior art discloses and teaches as to making the suggested configuration, the Examiner relies on assumption and statements without any support in the record. The Examiner relies on impermissible hindsight to avoid express limitations in the claims by making assertions regarding how the DiNatale invention may be adapted to recreate the claimed invention. Therefore, the Examiner has failed to establish a prima facie case of obviousness. Furthermore, it is respectfully submitted that the asserted motivation, to "ensure that all the capabilities included within the cable modem are utilized during operation," is too generic to motivate one of ordinary skill in the art to make the proposed modifications.

It is further respectfully submitted that claims 3,4 and 7 are allowable even in view of the Examiner's asserted combination of references since DiNatale fails to cure all the deficiencies of Roeck with respect to independent claim 1 that were submitted previously with regard to the 102(e) rejection. Therefore, it is respectfully asserted that claim 1 is allowable over the cited references, as are claims 3, 4 and 7 based on their dependence from claim 1.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of Gatherer et al. ("Gatherer" U.S. Pat. No. 6,549,584). This rejection is respectfully traversed.

Applicant respectfully submits that the combination of the Roeck and Gatherer references is improper. It is respectfully requested that the reject be withdrawn.

Claim 5 has been amended to more clearly define the invention. The Examiner indicates, at paragraph 29 of the Office action, that Roeck "fails to teach of parsing information into parts with a delimiter in between" and asserts that Gatherer teaches "a parser function which processes the incoming bit stream into groups of bits of specific lengths which are for the data to be differentiated."

The Examiner further asserts, at paragraph 30 of the Office action, that Roeck and Gatherer are analogous art because "they both are related to cable modem internal operations" and further asserts, at paragraph 31 of the Office action, that "it would have been obvious to a person of ordinary skill in the art to use the parser function taught by Gatherer et al. with the device taught by Roeck et al." Moreover, the Examiner cites a portion of Gatherer, at pg. 10, ll. 52-56, to support the proposed combination of references on the basis that "the function can reduce errors inherently speeding up the process."

As was previously noted with respect to the rejection of claim 2, the Roeck invention is directed to "enabling a cable modem to efficiently detect a data carrier in the downstream band" and the present invention is directed to "a file download apparatus and method ... that is capable of shortening the time required for initializing a cable modem." It is further respectfully noted that the Gatherer invention is directed to "coding techniques for high data rate transmissions via cable modems." See Gatherer at col. 1, lines 13-15. Although the Roeck and Gatherer references may both be related to the same general art, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to look to an invention (Gatherer) directed to "coding techniques for high data rate transmissions via cable modems" for ways to modify an invention (Roeck) directed to "efficiently detect[ing] a data carrier" in order to meet the need (of the present invention) of "shortening the time required for initializing a cable modem."

It is further respectfully submitted that the Examiner has not asserted the proper motivation for modifying the Roeck invention with the teachings of the Gatherer reference and is engaging in hindsight reconstruction of the claimed invention. For example, the Examiner has not pointed to any portion of the Roeck reference or Gatherer reference that would motivate one of ordinary skill in the art to make the proposed modification of the Roeck invention.

The Examiner cites a portion of the Gatherer invention that supports only the proposition that the **Gatherer** invention may be modified such that "message processor parses the format of the detected configuration file name information into a configuration file name part and a configuration file version part on the border of a delimiter part therebetween" as recited in claim 5. It is respectfully submitted that the Examiner has only shown "the mere fact that a reference may be modified in the direction of the claimed invention." However it is the **Roeck** invention, not the Gatherer invention, that the Examiner is proposing to modify and the only motivation the Examiner asserts outside the Gatherer reference are the teachings of the **present** invention.

Rather than pointing to what the prior art discloses and teaches as to making the suggested configuration, the Examiner relies on assumptions and statements without any support in the record. The Examiner relies on impermissible hindsight to avoid express limitations in the claim by making assertions regarding how the Gatherer invention may be adapted to recreate the claimed invention. Therefore, the Examiner has failed to establish a prima facie case of obviousness. Furthermore, it is respectfully submitted that asserted motivation, to "reduce errors inherently speeding up the process," is too generic to motivate one of ordinary skill in the art to make the proposed modifications.

It is further respectfully submitted that the Examiner's asserted combination of references fails to teach a "delimiter part" between the "configuration file name part" and "configuration file version part" as recited in claim 5. It is further respectfully submitted that no "delimiter part" is disclosed in Roeck. Moreover, it is respectfully submitted that the "parser function 33" of Gatherer forwards "one portion of each group of bits ... directly to QAM map function 37" and "forwards four bits to each of convolutional coders 35_I and 35_Q" and that neither this disclosure, nor the "groups of bits of specific lengths" to which the Examiner refers, are sufficient to disclose a "delimiter part." Therefore, it is respectfully asserted that claim 5 is allowable over the cited references.

Moreover, it is respectfully submitted that claim 5 is allowable even in view of the Examiner's asserted combination of references since Gatherer fails to cure all the deficiencies of Roeck with respect to independent claim 1 that were submitted previously with regard to the

102(e) rejection. Therefore, it is respectfully asserted that claim 1 is allowable over the cited references, as is claim 5 based on its dependence from claim 1.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of Gatherer as applied to claim 5 and further view of DiNatale. This rejection is respectfully traversed.

Applicant respectfully submits that the combination of the Roeck, Gatherer and DiNatale references is improper. It is respectfully requested that the reject be withdrawn.

The Examiner indicates, at paragraph 33 of the Office action, that the combination of Roeck and Gatherer "lacks the format of the configuration file format" and asserts that DiNatale teaches "a file format which has the file name part with the file version included" and "[e]ach field is designated which differentiates the fields of the file." The Examiner further asserts, at paragraph 34 of the Office action, that Roeck, Gatherer and DiNatale are analogous art because "they [all] are related to cable modem data handling operations" and further asserts, at paragraph 35 of the Office action, that "it would have been obvious to a person of ordinary skill in the art to use the file format of DiNatale in the apparatus of Roeck et al. as modified by Gatherer." Moreover, the Examiner cites a portion of DiNatale, at pg. 7, ll. 4-7, to support the proposed combination of references on the basis that "the [DiNatale] file allows the cable system operator to configure all of its cable modems, irrespective of the manufacturer of the cable modem or the model, to operate with the operating software intended for that cable modem."

As was previously noted with respect to the rejection of claim 5, the Roeck invention is directed to "enabling a cable modem to efficiently detect a data carrier in the downstream band," the Gatherer invention is directed to "coding techniques for high data rate transmissions via cable modems" and the present invention is directed to "a file download apparatus and method ... that is capable of shortening the time required for initializing a cable modem." As was previously noted with regard to the rejection of claim 5, although the Roeck and Gatherer references may both be related to the same general art, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to look to an invention (Gatherer) directed to "coding techniques for high data rate transmissions via cable modems" for ways to modify an invention (Roeck) directed to "efficiently detect[ing] a data carrier" in order to meet the need (of the present invention) of "shortening the time required for initializing a cable modem."

As was previously submitted with regard to the rejection of claim 5, the Examiner has not asserted the proper motivation for modifying the Roeck invention with the teachings of the Gatherer reference. It is further respectfully submitted that the Examiner has not asserted the

proper motivation for modifying the combination of the Roeck and Gatherer inventions with the teachings of the DiNatale reference and is engaging in hindsight reconstruction of the claimed invention. For example, the Examiner has not pointed to any portion of the Roeck, Gatherer or DiNatale references that would motivate one of ordinary skill in the art to make the proposed modification of combination of the Roeck and Gatherer inventions.

The Examiner cites a portion of the DiNatale invention that supports only the proposition that the **DiNatale** invention may be modified such that "the format of the configuration file name information includes a file name part indicating a configuration file name, a file version part indicating a configuration file version information, and a delimiter part differentiating the file name part and the file version part" as recited in claim 6. It is respectfully submitted that the Examiner has only shown "the mere fact that a reference may be modified in the direction of the claimed invention." However it is the combination of the **Roeck** and **Gatherer** inventions, not the DiNatale invention, that the Examiner is proposing to modify and the only motivation the Examiner asserts outside the DiNatale reference are the teachings of the **present** invention.

Rather than pointing to what the prior art discloses and teaches as to making the suggested configuration, the Examiner relies on assumptions and statements without any support in the record. The Examiner relies on impermissible hindsight to avoid express limitations in the claim by making assertions regarding how the DiNatale invention may be adapted to recreate the claimed invention. Therefore, the Examiner has failed to establish a prima facie case of obviousness. Furthermore, it is respectfully submitted that asserted motivation, that the DiNatale file "allows the cable system operator to configure all of its cable modems, irrespective of the manufacturer of the cable modem or the model, to operate with the operating software intended for that cable modem," is too generic to motivate one of ordinary skill in the art to make the proposed modifications.

It is further respectfully submitted that the Examiner's asserted combination of references fails to teach "a delimiter part differentiating the file name part and the file version part" as recited in claim 6. As was previously submitted with regard to the rejection of claim 5, no "delimiter part" is disclosed in Roeck or Gatherer. It is further respectfully submitted that DiNatale also fails to disclose a "delimiter part."

It is further respectfully submitted that claim 6 is allowable even in view of the Examiner's asserted combination of references since DiNatale fails to cure all the deficiencies of Roeck and Gatherer with respect to independent claim 1 that were submitted previously with regard to the rejection of claim 5. Therefore, it is respectfully asserted that claim 1 is allowable over the cited references, as is claim 6 based on its dependence from claim 1.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Beser (U.S. Pat. No. 6,775,276). This rejection is respectfully traversed.

Applicant respectfully submits that the combination of the DiNatale and Beser references is improper. It is respectfully requested that the reject be withdrawn.

Claim 9 has been amended to more clearly define the invention. The Examiner indicates, at paragraph 37 of the Office action, that DiNatale "fails to teach of encoding the information in a boot file name region of a DHCP message format" and asserts that Beser teaches "an offer message being sent to a cable modem with configuration information in the boot file name region of a DHCP message." The Examiner further cites, at paragraph 39 of the Office action, to a portion of Beser, at col. 13, ll. 24-28 and table 4, to support the proposed combination of references on the basis that "the boot filename section of a DHCP message is used for sending the path and filename of a file for configuration purposes."

It is respectfully submitted that the Examiner has not asserted the proper motivation for modifying the DiNatale invention with the teachings of the Beser reference and is engaging in hindsight reconstruction of the claimed invention. For example, the Examiner has not pointed to any portion of the DiNatale or Beser references that would motivate one of ordinary skill in the art to make the proposed modification of the DiNatale invention.

The Examiner cites a portion of the Beser reference that supports only the proposition that the **Beser** invention may be modified such that "the configuration file version information is displayed by encoding it together with the configuration file name in a boot file name region of a dynamic host configuration protocol (DHCP) message format" as recited in claim 9. It is respectfully submitted that the Examiner has only shown "the mere fact that a reference may be modified in the direction of the claimed invention." However it is the **DiNatale** invention, not the Beser invention, that the Examiner is proposing to modify and the only motivation the Examiner asserts outside the DiNatale reference are the teachings of the **present** invention.

Rather than pointing to what the prior art discloses and teaches as to making the suggested configuration, the Examiner relies on assumptions and statements without any support in the record. The Examiner relies on impermissible hindsight to avoid express limitations in the claim by making assertions regarding how the Beser invention may be adapted to recreate the claimed invention. Therefore, the Examiner has failed to establish a prima facie case of obviousness.

It is further respectfully submitted that claim 9 is allowable even in view of the Examiner's asserted combination of references since Beser fails to cure all the deficiencies of DiNatale with respect to independent claim 8 that were submitted previously with regard to the

102(e) rejection. Therefore, it is respectfully asserted that claim 8 is allowable over the cited references, as is claim 9 based on its dependence from claim 8.

Claims 12, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Gatherer. This rejection is respectfully traversed.

Applicant respectfully submits that the combination of the DiNatale and Gatherer references is improper. It is respectfully requested that the reject be withdrawn.

Claims 12, 17 and 18 have been amended to more clearly define the invention. The Examiner indicates, at paragraphs 41, 44 and 47 of the Office action, that DiNatale "fails to teach of parsing the information as received into a name part and version part" and asserts that Gatherer teaches "a parser function which processes the incoming bit stream into groups of bits of specific lengths which are for the data to be differentiated." The Examiner further asserts, at paragraphs 42 and 45 and 48 of the Office action, that DiNatale and Gatherer are analogous art because "they both are related to cable modem operating" and further asserts with respect to claims 12 and 17, at paragraphs 43 and 46 of the Office action, that "it would have been obvious to a person of ordinary skill in the art to use the parser function taught by Gatherer et al. with the method taught by DiNatale et al." Moreover, the Examiner cites a portion of Gatherer, at pg. 10, ll. 52-56, to support the proposed combination of references on the basis that "the function can reduce errors inherently speeding up the process."

As was previously noted with respect to the rejection of claim 2, the Gatherer invention is directed to "coding techniques for high data rate transmissions via cable modems" and the present invention is directed to "a file download apparatus and method ... that is capable of shortening the time required for initializing a cable modem." It is further submitted that, although the DiNatale and Gatherer references may both be related to the same general art, one of ordinary skill in the art would not have been motivated to look to an invention (Gatherer) directed to "coding techniques for high data rate transmissions via cable modems" in order to meet the need (of the present invention) of "shortening the time required for initializing a cable modem."

It is further respectfully submitted, with regard to the rejection of claims 12 and 17, that the Examiner has not asserted the proper motivation for modifying the DiNatale invention with the teachings of the Gatherer reference and is engaging in hindsight reconstruction of the claimed invention. For example, the Examiner has not pointed to any portion of the DiNatale reference or Gatherer reference that would motivate one of ordinary skill in the art to make the proposed modification of the DiNatale invention.

The Examiner cites a portion of the Gatherer invention that supports only the proposition that the **Gatherer** invention may be modified to parse the "first configuration file name information" as received "into a file name part and a version information part" as recited in claims 12 and 17. It is respectfully submitted that the Examiner has only shown "the mere fact that a reference may be modified in the direction of the claimed invention." However it is the **DiNatale** invention, not the Gatherer invention, that the Examiner is proposing to modify and the only motivation the Examiner asserts outside the Gatherer reference are the teachings of the **present** invention.

Rather than pointing to what the prior art discloses and teaches as to making the suggested configuration, the Examiner relies on assumptions and statements without any support in the record. The Examiner relies on impermissible hindsight to avoid express limitations in the claims by making assertions regarding how the Gatherer invention may be adapted to recreate the claimed invention. Therefore, the Examiner has failed to establish a prima facie case of obviousness. Furthermore, it is respectfully submitted that asserted motivation, to "reduce errors inherently speeding up the process," is too generic to motivate one of ordinary skill in the art to make the proposed modifications.

Moreover, it is respectfully submitted that claims 12, 17 and 18 are allowable even in view of the Examiner's asserted combination of references. With respect to claim 12, it is respectfully submitted that Gatherer fails to cure all the deficiencies of DiNatale with respect to independent claim 11 that were submitted previously with regard to the 102(e) rejection and, therefore, it is respectfully asserted that claim 11 is allowable over the cited references, as is claim 12 based on its dependence from claim 11.

With respect to independent claim 17, it is further respectfully submitted that the asserted combination of references fails to disclose all the recited limitations. As was previously submitted with regard to the rejection of independent claim 8, DiNatale fails to disclose a "configuration file with a ... delimiter part." As was previously submitted with regard to the rejection of claim 5, Gatherer fails to cure this deficiency, as it also does not disclose a "delimiter part." As was previously submitted with regard to the rejection of independent claim 11, DiNatale fails to disclose most of the other limitations recited. It is further respectfully submitted that Gatherer also fails to cure the deficiencies of DiNatale with regard to most of the other limitations. Therefore, it is respectfully asserted that independent claim 17 is allowable over the cited references. It is further respectfully asserted that claim 18, which depends from claim 17, also is allowable over cited references.

CONCLUSION

In light of the above remarks, Applicant submits that claims 1-18 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

The Examiner has cited multiple references as being made of record and not relied upon. Applicant has studied the references and believes they neither anticipate nor render obvious the present invention either alone or in combination.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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